

REMARKS

Reconsideration of this application, as amended is respectfully requested.

In the Office Action, the Examiner objected to the specification and to several claims and in addition rejected several claims under 35 U.S.C. § 112, first and second paragraphs. In response to these rejections and objections, the specification and claims have been amended to overcome the same. Withdrawal of the objections and rejections under 35 U.S.C. § 112 is respectfully requested.

In addition, the Examiner rejected claims 1-5 and 11 under 35 U.S.C. § 102(b) as being anticipated by Lilley, rejected claims 6, 7 and 8 under 35 U.S.C. § 103 as being unpatentable over Lilley, rejected claims 9 and 12-19 under 35 U.S.C. § 103 as being unpatentable over Lilley in view of Sayag and rejected claim 10 under 35 U.S.C. § 103 as being unpatentable over Lilley in further view of Steinberg. In response to the rejections, claims 1 and 12 have been amended to include the features of generating a verification impossible signal when it cannot be determined whether or not the detected fingerprint image is coincident with any of the registered fingerprint images and that the first light emitting device is continued to be turned on in response to the revocation and possible signal. These features are not disclosed nor obvious from any of the cited prior references either taken alone or in any proper hypothetical combination.

The present invention is directed to a fingerprint verifying apparatus that comprises first and second light emitting devices, which emit light at first and second colors, respectively. An imaging unit detects an image of a fingerprint and a fingerprint verifying circuit compares the detected fingerprint image with registered fingerprint images to determine whether the detected image is coincident with any of the registered images. The circuit outputs a match signal when the detected fingerprint image is coincident with one of the registered fingerprint images. In this case, a drive circuit turns on the second light emitting device in response to the matched signal. In addition, the verification circuit outputs a verification impossible signal when it cannot be determined whether or not the detected fingerprint image is coincident with one of the registered fingerprint images. In this second case, the first light emitting device continues to be turned on in response to the verification impossible signal.

The features relating to the verification impossible signal were formerly present in claim 14, which has now been cancelled. Claims 1 and 12 have been amended to include these features. In rejecting claim 14, the Examiner did not cite to a disclosure in any of the cited references of a verification impossible signal being generated when it cannot be determined whether the fingerprint image is coincident with any of the registered images and continuing the first light emitting device to be turned on in response to the verification impossible signal. Instead, the

Examiner took "official notice" that it would be obvious to a person of ordinary skill in the art to generate a verification impossible signal and to continue the first light emitting device in response to the signal. First, Official Notice is something that can only be taken in regard to a fact or a technical feature that is known in the art. See, MPEP 2144.04. The Examiner cannot take Official Notice that a feature "would have been obvious to a person of ordinary skill in the art". Official Notice cannot be used to relieve the Examiner of the obligation of presenting evidence of a suggestion or teaching in the references to combine the fact alleged to be known by Official Notice with the cited references. Since there is no reference cited by the Examiner for the fact taken by Official Notice, the teaching or suggestion can only be in the cited references. The Examiner has not pointed to any such teaching or suggestion in the cited references to combine with the Official Notice fact, because there is none.

Moreover, it is submitted that the taking of Official Notice of the generation and verification impossible signal and the continuing of the first light emitting device to be turned on in response to a verification impossible signal is improper. The Examiner contends that this is simply a common default mode. However, this statement makes no sense as a default mode is generally understood to be a preprogrammed mode. Furthermore, a verification impossible signal is simply not a common default mode. The common modes are pass or fail. The cited references

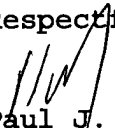
teach a light signaling that the fingerprint is matched or light signaling that there is no match. There is no teaching or suggestion of a third option of signaling not that it is impossible to determine whether there is a match. This is clearly a new and unobvious third mode not disclosed or taught in the prior art references. The specification of the present application indicates that the color of the first light-emitting device is yellow which is suitable for an expression that verification cannot be determined. See page 15, lines 2-6. This is a disclosure that the first light-emitting device is a signal indicator that can be seen by the person using the fingerprint verifying apparatus. There is no disclosure in any of the cited references of such an indicating signal being visible while the matching is being attempted.

The Examiner's alleged example that provides motivation is simply a hindsight statement of the applicant's invention as recited in original claim 14, which is now present in amended claims 1 and 12. Therefore, the Examiner has improperly taken Official Notice and also improperly applied Official Notice in the rejection of claim 14. Therefore, claims 1 and 12, as amended, are allowable over the cited references.

In addition, claims 21 and 22 have been added to recite the additional feature of the first light emitting device being continued to be turned on for a predetermined time period in response to the verification impossible signal, a feature also not disclosed or suggested in the cited references.

Based on the above, it is respectfully submitted that all of the claims in the application contain patentable subject matter and a Notice of Allowance is respectfully solicited.

Respectfully submitted,


Paul J. Esatto, Jr.
Registration No. 30,749

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343/4366 Fax

PJE:ae